REMARKS

The Office Action mailed 7 November 2008, has been received and its contents carefully noted. Claims 1-9 were pending. Claims 1-5 and 7 were rejected and claims 6, 8, and 9 were withdrawn from consideration. By this amendment, claims 10-18 have been added, and claims 1-9 have been canceled. Support may be found in the specification and the claims as originally filed. No statutory new matter has been added. Therefore, reconsideration and entry of the claims as amended are respectfully requested.

Priority Claim

The Examiner states that the benefit of the international application cannot be granted until the specification is amended to reflect the claim to international application PCT/CN05/00195.

Applicants respectfully submit that the specification need not be amended to reflect the claim to PCT/CN05/00195 (PCT '195) in order to receive the benefit claim since PCT '195 is not an application under 35 U.S.C. 111(a) but is instead an application under 35 U.S.C. 371.

Nevertheless, Applicants have amended the specification to reflect the claim to PCT/CN05/00195. Therefore, Applicants respectfully request that the benefit of PCT/CN05/00195 and CN 200410021172.3 is acknowledged.

Rejection under 35 U.S.C. 102(b)

The Examiner rejected claims 1-5 and 7 under 35 U.S.C. 102(b) as being anticipated by Liu (CN 200410021172.3). Specifically, the Examiner deemed that Liu teaches the claimed invention in claims 1-5.

Applicants respectfully submit that Liu is Applicants' own priority application and can not be used as a prior art reference against the instant claims. Therefore, the rejection under 35 U.S.C. 102(b) should be withdrawn.

Rejection under 35 U.S.C. 103(a)

The Examiner rejected claims 1-5 and 7 under 35 U.S.C. 103(a) as being unpatentable over Desbordes (WO99/33812). Specifically, the Examiner deemed that it would be obvious to make the substituted azole compounds of the instant invention based upon the compound taught by Desbordes.

Applicants respectfully urge that the compound structure of the compounds according to the instant claims greatly differ from those set forth in Desbordes. Although compounds **100** and **103** of Desbordes and the compounds of the present invention are all related to strobin derivatives with substituted pyrazole, there are still significant and clear differences between Desbordes compounds and the compounds of the instant claims. For example, Desbordes compounds **100** and **103** are joined at position 3 of pyrazole (herein referred to as "position 3 isomers") as compared to position 5 of the inventive compounds (herein referred to as "position 5 isomers").

Although the Examiner asserts that King teaches that all halogens and –CN are bioisosteres of each other and that positional isomers are expected to possess similar properties, Applicants respectfully submit that King states on page 207 (emphasis added):

> It is therefore unlikely that bioiososterism will produce marked increases in potency; however significant changes in selectivity, toxicity, and metabolic stability could be expected.

King also states on page 209 (emphasis added):

> ... alteration of one part of the molecule almost always affects more than just one property ... For example a simple CH_2 to O to S series of replacements can alter size, shape, electronic distribution ... all with unpredictable effects upon biological activity.

Thus, as recognized by those skilled in the art, the physicochemical properties of positional isomers (compounds with a substituent in different positions) are expected to be significantly different between each other. In addition, those skilled in the art also recognize that positional isomers have unpredictable differences in their bioactivities. Consequently, one of ordinary skill in the art would not have been motivated to obtain a positional isomer of a given compound with a reasonable expectation of success in obtaining a desired physicochemical

property or a desired bioactivity.

In addition, Desbordes does not provide any bioactivity data for compounds **100** and **103**. In order to render a claimed compound prima facie obvious, the motivation to modify the prior art must flow from some teaching that suggests the desirability or incentive to make the modified compound. See Alza Corp v. Mylan Laboratories Inc., 391 F.3d 1365 (Fed. Cir. 2004). There must be some motivation for selecting the (lead) compound in the prior art and then modify the lead compound to arrive at the claimed compound, e.g. manipulate/modify certain parts of the lead compound by ring walking, changing substituents, performing bioisosteric substitutions, etc. See e.g. Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc. 231 F.3d 1339, reh'g denied (Fed. Cir. 2000) and Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd., No. 06-1329 (Fed. Cir. 2007).

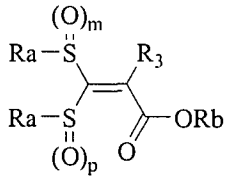
Because of the lack of any bioactivity data for compounds **100** and **103** and no suggestion that a position 5 isomer may exhibit any or better bioactivity, one of ordinary skill in the art would not have been motivated to make the claimed position 5 isomers in order to obtain compounds exhibiting high insecticidal and antifungal bioactivity with a reasonable expectation of success. Despite the knowledge in the art (e.g. Desbordes), Applicants unexpectedly found that the claimed position 5 isomers exhibit high bioactivities. Specifically, as set forth in the instant specification, the claimed position 5 isomers exhibit 100% insect and fungal control at 50 ppm. Because those skilled in the art would have expected different physicochemical properties and unpredictable bioactivities between positional isomers, one of ordinary skill in the art would not have been motivated to obtain position 5 isomers with a reasonable expectation of success in achieving 100% insect and fungal control at 50 ppm

The Examiner asserted that Desbordes also disclosed compounds **50, 65, 70,** and **88** (wherein W is a bond and the G is G4). Applicants respectfully submit that the functional group of the Desbordes compounds **50, 65, 70,** and **88** joining with phenyl is methoxylcarbamate. In contrast with the Desbordes compounds, the compounds of the present invention are methoxyacrylate derivatives and their bioactivities have relationship with the pyrazole ring. Again, Applicants respectfully submit that in order to render a claimed compound prima facie obvious, the motivation to modify the prior art must flow from some teaching that suggests the

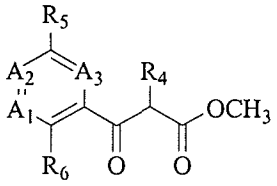
desirability or incentive to make the modified compound. Nowhere has the Examiner provided any logical reasoning one of ordinary skill in the art would have been motivated to first select one of the 4 Desbordes compounds and then modify it in such a way that it becomes a methoxyacrylate derivative according to the instant invention as claimed.

Further, Applicants respectfully submit that the instant compounds as claimed can not be prepared according to that disclosed in Desbordes. Specifically, the synthesis methods and starting materials required for obtaining the instant compounds are different from that of Desbordes due to the different positions of the substituents. The compounds of the invention can not be prepared by using the starting materials and methods given by Desbordes.

The starting material disclosed in Desbordes is:



The starting material for obtaining the compounds of the present invention is:



In order to render a claimed compound obvious, the prior art must disclose of method of making a structurally similar compound. See In re Hoeksema, 399 F.2d 269 (CCPA 1968). Nowhere has the Examiner explained how one of ordinary skill in the art would be able to obtain the claimed position 5 isomers. Since the starting materials and methods of Desbordes will not result in the position 5 isomers of the present invention and the Examiner has not set forth the motivation and modification that one would do to the starting materials and methods of Desbordes to obtain the invention as claimed, a prima facie case of obviousness has not been established.

Therefore, Applicants respectfully submit that claimed invention is unobvious and the rejection under 35 U.S.C. 103(a) should be withdrawn.

Request for Rejoinder

Applicants respectfully submit that claims 16 and 17 (formerly claims 8 and 9) are of the same scope as the composition claims which are believed to be allowable. Therefore, rejoinder and examination of claims 16 and 17 are respectfully requested.

Request for Interview

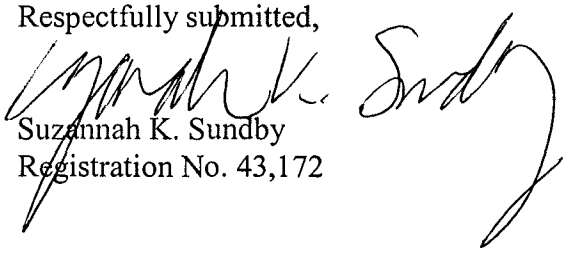
Either a telephonic or an in-person interview is respectfully requested should there be any remaining issues.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Therefore, it is respectfully requested that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Official action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. 1.136(a), and any fees required therefor are hereby authorized to be charged to **Deposit Account No. 02-4300**, Attorney Docket No. **034226 M 003**.

Respectfully submitted,



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